

Examiner in writing the Examiner's Answer. Entry of the proposed Rule 116 Amendment would also reduce and simplify the burden on Applicants in preparing the Brief on Appeal, and result in a shorter and simpler Brief.

The "new issues that would require further consideration and/or search" are identified by the Examiner in the Continuation Sheet to the Advisory Action as follows:

The amended claim 7 reciting that the rim liner is disposed inside the rim and the rim having such characteristics raise new issues that would require further consideration and/or search.

Applicants respectfully assert that the addition of the limitation that the rim liner is "inside said flywheel rim" is not a new issue and was already searched and considered by the Examiner in his consideration of original and amended claim 15, which called for an annular rim liner engaged with the inner circumferential surface of an annular rim. Claim 15, as originally filed, calls for

15. A flywheel system, comprising:
a hub;
a flywheel rim concentric on said hub having a carbon fiber/epoxy outer annulus and, contiguous therewith, an E-glass inner annulus with an inner circumferential surface;
a rim liner engaged with said inner circumferential surface of said inner annulus;
said rim liner being made of a material that grows radially with said rim and has sufficient strength to transmit torque between said rim and said hub during flywheel spin-up and during energy recovery from said flywheel; and
a torque coupling between said hub and said rim liner that allows said liner to grow radially with respect to said hub while remaining concentric thereto during high speed operation.

This claim 15 does not specifically say, in so many words, that the rim liner is "inside said flywheel rim", but there is no other possible logical interpretation to the third limitation, emphasized in bold above.

The limitation, that the rim liner is "inside said flywheel rim", proposed in Applicants' Rule 116 amendment to claim 7 that the Examiner finds to offend the rule against introducing amendments after final that raise new issues or require further consideration and/or search was added merely to provide antecedent basis for the


primary limitations copied from claim 3, which is allowable over the prior art but was rejected only under §112.

The rejection under §112, 1st ¶, was addressed, pursuant to the Examiner's suggestion, in an affidavit. The rejection under §112, 2nd ¶, was addressed, pursuant to the Examiner's suggestion, in the amendments to claims 7, 10, 13, 15 and 18. These parts of the proposed Rule 116 amendment therefore should be enterable under the rule.

Accordingly, Applicants believe that the amendment to claim 7 merely inserts subject matter that the Examiner has already searched and considered and which the Examiner has already found to be patentable under 35 USC 102 and 103, and therefore greatly simplifies the issues to be considered by the Board of Appeals. Accordingly, Applicants believe that their proposed Amendment under Rule 116 should be allowed entry and respectfully request that the Examiner, after considering the issue, enter the proposed amendment for purposes of appeal.

Respectfully submitted,

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